

REMARKS

By this Amendment, Applicant amends claims 37, 40, 42, and 45. Claims 37-45 remain pending in this application.

In the Office Action,¹ the Examiner rejected claims 37-39, 41, 42, and 44 under 35 U.S.C. § 102(b) as anticipated by O'Leary et al. (U.S. Patent No. 5,249,967); rejected claim 45 under 35 U.S.C. § 102(b) as anticipated by Security CCTV, "Point-of Sale Monitoring Downsizes for Small Venues"; and rejected claims 40 and 43 under 35 U.S.C. § 103(a) as obvious over O'Leary in view of Piater (WO 93/11519).

Applicant respectfully traverses the rejection of claims 37-39, 41, 42, and 44 under 35 U.S.C. § 102(b) as anticipated by O'Leary. In order to anticipate Applicant's claimed invention under 35 U.S.C. § 102(b), the Examiner must demonstrate the presence of each and every element of the claim in issue, either expressly described or under principles of inherency, in a single prior art reference. Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim." See M.P.E.P. § 2121 (8th ed., Aug. 2001), *quoting* Richardson v. Suzuki Motor Co., 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Finally, "[t]he elements must be arranged as required by the claim." M.P.E.P. § 2131 (8th ed. 2001), p. 2100-69.

Claim 7 recites a method of providing video instruction to a user including, among other steps, "presenting the instructional signal to the user in real-time in a

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

manner that allows the user to perform the physical activity while viewing the instructional signal.” O’Leary does not teach at least this step of claim 37.

Applicant notes that the differences between O’Leary and the present invention are set out in Applicant’s specification in the “Description of Related Art” section. As described in that section, it is noted that “[a]lthough the O’Leary patent provides rapid feedback to the student, it requires the student [] to move his head away from the natural position of the golf swing to see the instructional video, thereby disrupting the natural swing.” See Applicant’s specification, page 1; see also O’Leary, FIG. 1 showing mirror 22 to view the instructional view. Since O’Leary requires a user to look away from the activity, it does not teach “presenting the instructional signal to the user in real-time in a manner that allows the user to perform the physical activity while viewing the instructional signal,” as recited in claim 37. The Examiner has therefore not shown that O’Leary anticipates all of the features of claim 37 and the rejection should be withdrawn.

Independent 42, while of a different scope, includes similar recitations as claim 37, and is not anticipated for the same reason. Claims 38, 39, 41, and 44 depend from claims 37 and 42, and are not anticipated at least due to their dependence. The Examiner should thus also withdraw the rejection of claims 38, 39, 41, 42, and 44.

Applicant respectfully traverses the rejection of claim 45 under 35 U.S.C. § 102(b) as anticipated by Security CCTV, “Point-of Sale Monitoring Downsizes for Small Venues” (“Security”).

Claim 45 recites a method including, among other steps, a step of “sending the instructional signal to a display in real-time in a manner that allows the user to perform

the physical activity while viewing the instructional signal.” “Security” does not teach at least this feature of claim 45.

By contrast, “Security” describes a monitoring system for monitoring sales cashiers. According to “Security,” “[o]ne camera focuses on the register and what’s being rung up, while the other shows the cashier and the item in question.” See col. 1, paragraph 3. However, in the “Security” system, the cashier does not monitor herself. Instead, “Security” describes that the system is a “management tool,” whereby managers “watch a new hire . . . for training or constructive criticism.” See col. 2, paragraph 3. It is thus the managers that watch the cashiers engaged in their work. Accordingly, “Security” does not teach “sending the instructional signal to a display in real-time in a manner that allows the user to perform the physical activity while viewing the instructional signal,” as recited in claim 45. The Examiner should therefore withdraw the rejection of claim 45 under 35 U.S.C. § 102(b) for this reason.

Applicant respectfully traverses the rejection of claims 40 and 43 under 35 U.S.C. § 103(a) as obvious over O’Leary in view of Piater. To establish a proper *prima facie* case of obviousness under 35 U.S.C. § 103(a), the Examiner must demonstrate each of three requirements. First, the reference or references, taken alone or combined, must teach or suggest each and every element recited in the claims. See M.P.E.P. § 2143.03 (8th ed. 2001). Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. See M.P.E.P. § 2143.01 (8th ed. 2001). Third, a reasonable expectation of success must exist. See M.P.E.P. § 2143.02 (8th ed. 2001). Moreover, each of these

requirements must be found in the prior art, not in applicant's disclosure. See M.P.E.P. § 2143 (8th ed. 2001).

Claims 40 and 43 depend from allowable independent claims 37 and 42, respectively. As discussed above, O'Leary does not disclose or suggest all of the features of claims 37 and 42. Furthermore, the Abstract of Piater, which is the only portion of the reference written in the English language, does not make up for the above described deficiencies of O'Leary. For example, the Abstract discloses that the Piater system uses a monitor or a projector with a screen. However, the Abstract does not make up for the deficiencies of O'Leary. Accordingly, the Examiner should withdraw the rejection of claims 40 and 43 at least due to their dependence from claims 37 and 42, respectively.

Furthermore, while the Abstract of Piater is written in English, the rest of the document is not. To the extent that the Examiner has relied upon portions of Piater that are written in the German language, Applicant respectfully traverses the application by the Examiner of the reference. Applicant directs the Examiner's attention to M.P.E.P. § 706.02, which states in the section captioned "Reliance Upon Abstracts and Foreign Language Documents in Support of a Rejection" that when a document is in a language other than English and the Examiner seeks to rely on that document, a translation must be obtained so that the record is clear as to the precise facts the Examiner is relying upon in support of the rejection. Applicant therefore submits that if the Examiner continues to rely upon Piater, the Examiner must provide a translation or else withdraw the rejection.

CONCLUSION

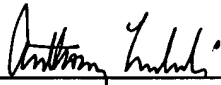
In view of the foregoing remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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